

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Initially, it is noted that the outstanding Office Action indicates that copies of the priority documents have not been received. However, the present application is a divisional of Application Serial No. 09/632,212. As indicated on the Request for Priority file June 24, 2003, certified copies of the priority documents were filed in Application Serial No. 09/632,212. Applicants respectfully request that the next official communication from the U.S. Patent and Trademark Office indicate that copies of the priority documents have been received.

Claims 55-69 are pending in the present application, Claims 55, 56, 58, 60, 61, 63, 65, 66, and 68 having been amended. Support for the amendments to Claims 55, 56, 58, 60, 61, 63, 65, 66, and 68 is found, for example, in the specification on pages 80-115. Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, the abstract was objected to; and Claims 55-69 were rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

With respect to the objection to the abstract, a new abstract is provided. The outstanding Office Action does not specifically identify the deficiencies believed to be in the prior Abstract. The outstanding Office Action merely reminds applicant of the proper language and format for an Abstract. Applicant respectfully submits that the new Abstract complies with the requirements for an Abstract. If the Examiner should disagree, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to draft a mutually satisfactory Abstract.

With respect to the rejection of Claims 55-69 under 35 U.S.C. §112, second paragraph, Applicants respectfully submit that the amendments to the claims overcome this

ground of rejection. Claims 55, 56, 58, 60, 61, 63, 65, 66, and 68 are amended to more clearly describe and distinctly claim the subject matter regarded as the invention.

The outstanding Office Action takes the position that the “document name generating part” is unclear. Amended Claim 55 recites, *inter alia*, “a document name generating part configured to cause a document name of the second document data obtained from coupling the plurality of document data to be a document name of one of the plurality of document data from which the coupling is thus carried out, and to use the document name of the second document data as file names of the plurality of document data from which the second document data is thus obtained.”

In a non-limiting embodiment of the claimed invention, a document C is obtained from coupling documents A and B. A document name of the new document C is set to be a document name of one of the documents A or B coupled together to form document C (for example, document A). Also, original documents A and B, which become respective sections of the new document C, are renamed A-1, A-2..., A-n.

Accordingly, this ground for rejection is believed to have been overcome. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

The outstanding Office Action takes the position that Claims 55-59 are incomplete for omitting essential elements. Applicants note that MPEP §2172.01 states “a claim which fails to interrelate essential elements of the invention as defined by the applicant(s) in the specification may be rejected under 35 U.S.C. §112, second paragraph for failure to point out and distinctly claim the invention” (emphasis added). Clearly, the PTO must follow its MPEP guidelines and must show where the present specification disclose that the alleged omitted essential elements are disclosed as essential before it can be on the path of making a

rejection under 35 U.S.C. §112, second paragraph that is based on omitted “essential elements.”

Furthermore, Applicants note that MPEP §2172.01, which quotes the decisions in Ex Parte Nolden, 149 USPQ 378, 380 (Bd. Pat. App. 1965) and Ex Parte Huber, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965), states:

that it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result; and

a claim does not necessarily fail to comply with 35 U.S.C. §112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly interoperate, and/or serve independent purposes.

Thus, Applicants respectfully submit that the pending claims satisfy the requirements of 35 U.S.C. §112, second paragraph.

Furthermore, Applicants note the decision in In re Miller, 169 USPQ 597, 600 (CCPA 1971), stating that “breadth is not to be equated with indefiniteness.”

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

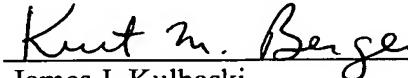
Respectfully submitted,

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